



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/634,691	08/08/2000	Hoyt A. Fleming III	500122.02	6789

7590 03/26/2002

Edward W Bulchis Esq
Dorsey & Whitney LLP
1420 Fifth Avenue Suite 3400
Seattle, WA 98101-4010

EXAMINER

LE, HIEU C

ART UNIT PAPER NUMBER

2153

DATE MAILED: 03/26/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

[Handwritten signature]

Office Action Summary

Application No.

09/634,691

Applicant(s)

FLEMING, HOYT A.

Examiner

Hieu c. Le

Art Unit

2153

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14, 16, 17 and 20-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-17, 20-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Art Unit: 2153

Response to Arguments

1. The Amendment file 1/14/02 have been entered and made of record.
2. The Applicant's argument filed 1/14/02 have been fully considered but they are not persuasive with regard to claims 1, 3, 6, 11, 16-17, 19 and 24-27 for the following reasons:

As to claim 1, Applicant alleges that "Hashimoto do not teach or suggest sending an unauthorized e-mail to deleted message folder [,]" (P. 4, lines 28- P. 5, line 1). This argument is not persuasive. Firstly, Hall discloses rejecting unauthorized messages by discarding the messages (i.e. forwarding the unauthorized message to a delete folder) (col. 22, lines 15-19). Furthermore, Hall discloses that the system allows the user to reject any e-mail arriving on a proper channel (i.e. the e-mail is rejected on the receiver's side) (col. 5, lines 17-19). Secondly, even though Hashimoto discloses that the unauthorized e-mail is abolished this does not mean that e-mail message is destroyed because conventional e-mail systems do not destroy message, they delete them and send them to a delete folder. Furthermore, the word "abolish" in the Merriam Webster's Collegiate Dictionary means "to end effect of", and conventional e-mail systems that use computers end the effect of (abolish) the message by deleting it and sending it to a delete folder (a deleted file in computer is not destroyed , it is send to a delete folder and could be read).

Claim Rejections - 35 U.S.C. § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

Art Unit: 2153

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

4. Claims 5-6, 8, 11-14, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Hall [US. Pat. No. 5,930,479].

As to claim 5, Hall discloses a method in a computer system for filtering unauthorized messages, each message having a sender, the method comprising:

for each of a plurality of messages (Fig. 2, items 208a, 210a),

determining whether the sender of the message is designated as being authorized [send mail lookup user's name in the system password file (a standard database defining the valid users of the system), and separates the address into name and channel ID, and matches the channel ID of the incoming message with one of the lines in the channels file 212 (col. 11, lines 40-49) for verify that the message is authorized for delivery to the recipient (Abstract, lines 7-8)];

when the sender of the message is determined to be authorized, indicating that the message is from an authorized sender (col. 11, lines 48-50); and

when the sender of the message is determined to be not authorized,

storing the message in a predesignated location for messages sent by unauthorized senders [unauthorized message are discarded (i.e. stored in a deleted folder) (col. 22, lines 15-19)].

As to claim 6, Hall further discloses wherein the recipient of the messages

Art Unit: 2153

can identify whether a message is authorized based solely on the indications [the message is either accepted or rejected (col. 11, lines 48-52)].

As to claim 11, Hall further discloses wherein the computer system includes a list of authorized senders (col. 10, lines 26-42 & Fig. 4) and wherein the determining whether the sender of the message is designated as being authorized includes determining whether the sender is in the list of authorized senders (col. 11, lines 40-49, col. 21, lines 56-63).

As to claim 12, Hall further discloses wherein the list of authorized senders is generated by adding the senders of the previously received messages to the list (col. 21, lines 56-63).

As to claim 13, Hall further discloses wherein the list of authorized senders is generated by adding the recipients of the previously sent messages to the list (col. 17, lines 26-30).

As to claim 14, Hall further discloses wherein the list is shared by multiple users (col. 9, lines 44-47, Fig. 2).

As to claim 16, Hall further discloses wherein when the recipient sends a message to an intended recipient, the intended recipient is added to the list as an authorized sender (col. 12, lines 57-61).

As to claim 8, Hall further discloses wherein the message is an electronic mail message and the pre-designated location is a folder [the message is an e-mail message (col. 5, line 8) and the authorized message is discarded (i.e. stored in a deleted file) (col. 22, lines 15-19)].

Art Unit: 2153

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 1-4, 20-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hall [US. Pat. No. 5,930,479] in view of Hashimoto et al. [US. Pat. No. 5,931,905].

As to claim 1, Hall discloses a method in a computer system for filtering unauthorized electronic mail messages that are sent by senders to a user, each sender having an identification each electronic mail message including the identification of the sender (col. 8, lines 48-53, col. 10, line 30-33), the method comprising:

providing a list of the identifications of the senders who are authorized to send an electronic mail message to the user [a user channel database (list) that records a channel ID and address of the correspondent (col. 10, lines 26-42)];

for each of a plurality of electronic mail messages (fig. 2, items 208a, 210a),
determining whether the sender of the electronic mail message is authorized by
determining whether the identification of sender in the electronic mail message is in the provided list of the identifications of the senders who are authorized [send mail lookup user's name in the system password file (a standard database defining the valid users of the system, and separates the

Art Unit: 2153

address into name and channel ID, and matches the channel ID of the incoming message with one of the lines in the channels file 212 (col. 11, lines 40-49) for verify that the message is authorized for delivery to the recipient (Abstract, lines 7-8)];

when the sender of the electronic mail message is determined to be not authorized, storing the electronic mail message in a second folder designated for electronic mail messages received from unauthorized senders [unauthorized messages are discard (i.e. send to in a deleted folder (second folder) (col. 2, lines 15-19)].

Hall discloses delivering the message to the user's machine when the sender is authorized (in the list of authorized senders and reject the message if the sender is not in the list (col. 11, lines 48-53) and discarding the message when the user is unauthorized (i.e. sent to a delete folder) (col. 22, lines 15-19).

Hall does not explicitly disclose,

when the sender of the electronic mail message is determined to be authorized, storing the electronic mail message in a first folder designated for electronic mail messages received from authorized senders.

whereby the electronic mail messages are automatically stored in the appropriate folder based on whether the sender is authorized so that the user can view the first folder containing the electronic mail messages sent by authorized senders separately from the second folder containing the electronic mail messages sent by unauthorized senders.

Art Unit: 2153

Hashimoto discloses a TV electronic mail system that uses an “authorized sender list” having identification numbers of the users permitted to send electronic mails and store it in an authentication database (col. 12, lines 37-41). If the user ID has been registered in the list the e-mail is sent to the receiver’s mail box (first folder) and can be viewed (col. 12, line 67-col. 13, line 4).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Hashimoto’s teaching to modify Hall’s method by storing the authorized e-mail in a user’s mail box in order to facilitate mail handling, particularly for some one receiving a large amount of e-mail and reduce the amount of junk e-mail he receives.

As to claim 2, Hall further discloses wherein when the user sends an electronic mail message to a recipient, the identification of the recipient is automatically added to the provided list of the identifications of senders who are authorized to send electronic mail message to the user (col. 12, lines 57-61).

As to claim 3, Hall further discloses wherein the provided list of the identifications of the senders is generated by adding the identification of senders of previously received electronic mail messages (col. 21, lines 56-63).

As to claim 4, Hall further discloses wherein the provided list of the identifications of the senders is generated by adding the identification of recipients of previously sent electronic mail messages (col. 17, lines 26-30).

As to claim 20, refer to claim 1 rejection.

Art Unit: 2153

As to claim 21, refer to claim 2 rejection.

As to claim 22, refer to claim 3 rejection.

As to claim 23, Hall uses a filter to reject unauthorized messages by discarding (i.e. forwarding the message to a delete folder) (col. 22, lines 15-19).

Hall does not explicitly disclose that the folder is labeled Junk mail. However, it is obvious to label a folder that is labeled discard and contains filtered e-mail from unauthorized sender and is used in the context of filtering Junk mail.

7. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall [US. Pat. No. 5,930,479] in view of Birrell et al. [US. Pat. No. 6,092,101].

As to claim 9, Hall does not disclose including when displaying a list of messages, displaying a visual indication as to whether the message has been indicated as being sent from an authorized or unauthorized sender.

Birrell discloses a system for filtering unauthorized messages, messages from authorized senders is placed in the Inbox (col. 11, lines 41-44) (i.e. the message is indicated by a label Inbox for the user's attention) messages from unauthorized senders only given the unread label (col. 11, lines 45-46), the messages are displayed and labeled as Inbox or unread (col. 9, lines 9-18).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Birell's teachings to modify Hall's method by displaying a visual indication (label) to indicate that the message is from authorized sender (Inbox) or unauthorized sender (unread) in

Art Unit: 2153

order to facilitate mail handing, particularly for some one receiving a large amount of e-mail and reduce the amount of junk e-mail he receives.

8. Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall [US. Pat. No. 5,930,479], in view of Birrell et al. [US. Pat. No. 6,092,101] as applied to claim 9 and further in view of Microsoft Corporation, "Excerpts from online documentation of Microsoft Exchange", version 5.0.1458.47, 1986-1997, 11pp.

As to claim 10, neither Hall nor Birell disclose the limitation, wherein the visual indication is the dimming of the messages that are sent from unauthorized senders in the list of messages.

Microsoft Corporation discloses a visual indication method used in e-mail message to dim profile message (page 8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Microsoft's teaching to modify the combined method of Hall and Birell by dimming the junk mail messages in the list of messages in order to indicate to the user that these messages are irrelevant to his interest and save him valuable hours to be wasted in dealing with junk mail.

10. Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hall [US. Pat. No. 5,930,479] in view of Birrell et al. [US. Pat. No. 6,092,101] as applied to claim 5 and further in view of Canale et al. [US. Pat. No. 5,619,648].

As to claim 17, neither Hall nor Birell disclose wherein the indicating that the message is from an unauthorized sender includes forwarding the message from an unauthorized to another user.

Art Unit: 2153

Canale discloses a method for reducing the amount of junk e-mail received by a user of an e-mail system. The mail filter for potential recipient has access to a list of the e-mail messages sent and received by the potential recipient and used the list of e-mail messages to determine correspondents of the potential recipient and forwards the messages to those recipients (col. 2, lines 27-44). The system permits the recipient of the e-mail to select which of the correspondents (another users) is to receive the e-mail (col. 4, lines 2-8).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Canale's teaching to modify the combined method of Hall and Birell' in order to facilitate mail handling, particularly for some one receiving a large amount of e-mail and reduce the amount of junk e-mail he receives.

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

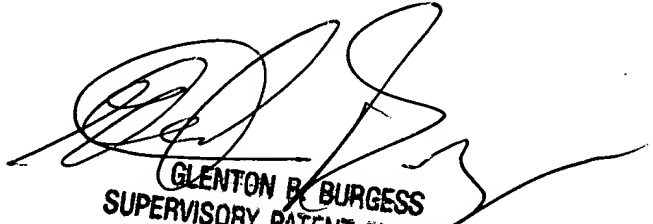
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Art Unit: 2153

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Hieu Le whose telephone number is (703) 306-3101. The examiner can normally be reached on Monday to Friday from 8:00 A.M. to 4:00 P.M..

The fax number of this Group 2757 is (703) 308-5397 or 308-9051 .

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.



GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100